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09/553,125	04/19/2000	Joseph M. Cannon	1298/OF148	3933

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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,125

Applicant(s)

CANNON ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US 5,631,950) in view of Latter et al. (US 6,178,232).

Regarding **claim 1**, Brown discloses a method for communicating an audio message between a calling telephone apparatus and a called telephone apparatus while the called telephone apparatus remains in an on-hook state, the calling telephone apparatus and the called telephone apparatus being connected to a telephone system

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(which reads on “a transmission of data message during silent intervals of ringing for selection of terminal equipment”), the method comprising the step of:

introducing a digitized version of the audio message (column 4, line 17 “a data messages”) relating to a call (column 4, line 22 “places calls”) from the calling telephone apparatus (column 4, line 21 “a calling terminal”) over a telephone line to the called telephone apparatus (column 4, line 17 “to the called link”) while the called telephone apparatus remains in the on-hook state (column 4, lines 16-46) [The switching office allows the calling party to transmit data messages to the called party during the silent intervals of the ringing signals].

Brown discloses a data message from the calling party but fails to disclose an audio message between a calling telephone apparatus and a called telephone apparatus.

However, Latter teaches an audio message (column 2, line 58 “the audible caller information”) between a calling telephone apparatus (40 on FIG. 1) and a called telephone apparatus (column 2, lines 36-62) [The system transmits the audible caller identification information from the calling apparatus 40 to the called communication station 30].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Brown using the audible caller identification information provided by the calling party as taught by Latter.

This modification would enable the system of Brown to provide caller identification information so that the user would receive the caller ID information effectively.

Regarding **claim 7**, Brown discloses an apparatus for communicating an audio message between a calling telephone apparatus and a called telephone apparatus while the called telephone apparatus remains in an on-hook state, the calling telephone apparatus and the called telephone apparatus being connected to a telephone system (which reads on “a transmission of data message during silent intervals of ringing for selection of terminal equipment”), comprising:

a silence detector (125 on FIG. 1) detecting a silent interval (column 3, line 60 “the silent interval”) following a ringing signal (column 3, line 61 “between ringing signals”) provided to the called telephone apparatus (column 3, lines 59-67) [The controller 125 detecting the silent interval between the ring signals of a called telephone link]; and

a signal injector (120 on FIG. 1) responsive to the silence detector, introducing a digitized version of the audio message (column 4, line 17 “a data message”) relating to a call (column 4, line 22 “places a call”) from the calling party telephone apparatus (column 4, line 21 “a calling terminal”) to the called telephone apparatus over a telephone line (column 4, line 22 “to this called link”) during the detected silent interval (column 4, lines 16-46) [The switching office allows the calling party to transmit data messages to the called party during the silent intervals of the ringing signals].

Brown discloses a data message from the calling party but fails to disclose an audio message between a calling telephone apparatus and a called telephone apparatus.

However, Latter teaches an audio message (column 2, line 58 "the audible caller information") between a calling telephone apparatus (40 on FIG. 1) and a called telephone apparatus (column 2, lines 36-62) [The system transmits the audible caller identification information from the calling apparatus 40 to the called communication station 30].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Brown using the audible caller identification information provided by the calling party as taught by Latter.

This modification would enable the system of Brown to provide caller identification information so that the user would receive the caller ID information effectively.

4. **Claims 2-3 and 8-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Latter and in further view of Guercio et al. (US 6,373,925).

Regarding **claims 2 and 8**, Brown and Latter as applied to **claims 1 and 7** differ from **claims 2 and 8** in that it fails to disclose a signal identifying the calling party during a silent interval following a first ringing signal provided to the called telephone

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apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message.

However, Guercio teaches introducing a signal identifying the calling party (column 7, line 56 "the calling party information") during a silent interval (column 7, line 57 "between a first ring signal and a second ring signal") following a first ringing signal (column 7, line 57 "a first ring") provided to the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message (column 7, lines 50-67) [The caller ID information is transmitted between the first and the second ringing cycles and the associated voice message is played back].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Brown using the calling party announcement system as taught by Guercio.

This modification would enable the system of Brown to improve a telephone answering method so that the user would receive the caller ID information before answering the call.

Regarding **claims 3 and 9**, Brown and Latter as applied to **claims 1 and 7** differ from **claims 3 and 9** in that it fails to disclose wherein the digitized version of the audio message is of sufficient duration to extend beyond a silent interval in which it begins.

However, Guercio teaches wherein the digitized version of the audio message is of sufficient duration to extend beyond a silent interval in which it begins (column 7,

lines 50-67) [The store voice message may also be playback in place of subsequent ring signals].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Brown using the calling party announcement system as taught by Guercio.

This modification would enable the system of Brown to improve a telephone answering method so that the user would receive the caller ID information before answering the call.

5. **Claims 4 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Hamrick et al. (US 6,466,653).

Regarding **claims 4 and 10**, Brown discloses transmission of data message during silent intervals of ringing for selection of terminal equipment (column 1, lines 16-19), ("a method for communicating an audio message between a calling telephone apparatus and a called telephone apparatus while the called telephone apparatus remains in an on-hook state, the calling telephone apparatus and the called telephone apparatus being connected to a telephone system" reads on Brown), the method comprising the steps of:

receiving a digitized version of the message (column 4, line 17 "a data messages") during a silent interval (column 4, line 18 "the silent intervals") following a ringing signal (column 4, line 18 "the silent intervals of the ringing signals") appearing at

the called telephone apparatus (column 4, lines 16-46) [The ICLD signal is detected between ring signals before the called party answers the phone].

Brown discloses the data message for the caller information but fail to disclose converting the digitized version of the audio message to an acoustic version thereof and introducing the acoustic version to a speaker to produce an audible version of the audio message.

However, Hamrick teaches converting the digitized version of the audio message (column 12, line 21 "the textual data") to an acoustic version thereof (column 12, lines 4-37) [The text-to-speech 110 converts the textual data format into an electrical speech signal]; and

introducing the acoustic version to a speaker (126 on FIG. 5) to produce an audible version (column 12, line 26 "an audible level") of the audio message (column 12, lines 4-37) [The loudspeaker converts the speech signal into an acoustical signal having an audible level appropriate for listening by the called party].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Brown using the text-to-speech and the loudspeaker driver as taught by Hamrick.

This modification would enable the system of Brown to provide compacted displayed caller ID information to a text-to-speech so that the called party would receive the caller ID information.

6. **Claims 5-6 and 11-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Hamrick and in further view of Guercio.

Regarding **claims 5 and 11**, Brown and Latter as applied to **claims 4 and 10** differ from **claims 5 and 11** in that it fails to disclose a signal identifying the calling party during a silent interval following a first ringing signal provided to the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message.

However, Guercio teaches introducing a signal identifying the calling party (column 7, line 56 "the calling party information") during a silent interval following a first ringing signal (column 7, line 57 "a first ring") provided to the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message (column 7, lines 50-67) [The caller ID information is transmitted between the first and the second ringing cycles and the associated voice message is played back].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Brown using the calling party announcement system as taught by Guercio.

This modification would enable the system of Brown to improve a telephone answering method so that the user would receive the caller ID information before answering the call.

Regarding **claims 6 and 12**, Brown and Latter as applied to **claims 4 and 10** differ from **claims 6 and 12** in that it fails to disclose wherein the digitized version of the audio message is of sufficient duration to extend beyond a silent interval in which it begins.

However, Guercio teaches wherein the digitized version of the audio message is of sufficient duration to extend beyond a silent interval in which it begins (column 7, lines 50-67) [The store voice message may also be playback in place of subsequent ring signals].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Brown using the calling party announcement system as taught by Guercio.

This modification would enable the system of Brown to improve a telephone answering method so that the user would receive the caller ID information before answering the call.

Response to Arguments

7. Applicant's arguments with respect to **claims 1-12** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


g.g.

May 16, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

